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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,572

Applicant(s)

ACKERMAN ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **Part III DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/5/03 has been entered.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the barrier recited in claims 23, 30, 35 and a fire-rated barrier recited in claim 37 must be shown or the feature(s) canceled from the claim(s). Examiner suggests showing reference number for the barrier and a fire-rated barrier. A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

Applicant is responsible for showing reference number for claimed invention.

3. Applicant is required to submit a proposed drawing correction in reply to this office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 line 6, " at least partially reestablishing a fire rating of the barrier" is confusing because it is not clear that what is partially?.

In claim 30 line 6, " at least partially reestablishing a fire rating of the barrier" is confusing because it is not clear that what is partially?.

In claim 35 line 6, " at least partially reestablishing a fire rating of the barrier" is confusing because it is not clear that what is partially?.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 23-28, and 30-40 as best understood, are rejected under 35

U.S.C. 102(e) as being anticipated by Rose (6,252,167).

Rose discloses:

Regarding claim 23, a method for assisting a compromised barrier 16 (wall, see fig 1, column 3 lines 35-40) comprising: a) providing a gasket 24 (a support, see fig 5, column 3 lines 60-67, column 7 lines 45-50) comprising fire retardant material (intumescent material, see column 3 lines 55-67, please note that as disclosed by applicants in the specification page 6, lines 5-15, applicant's disclose that intumescent material are known to those with ordinary skill in the art, see page 6 line 5.); b) placing the fire retardant gasket 24 between a faceplate 26 (a cover plate, see fig 5, column 5 lines 15-26, column 5 lines 60-67, column 8 lines 10-26) and an electrical box 12 (see fig 5, column 5 lines 15-

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26, column 8 lines 10-26) adapted to be introduced into the barrier 16 (wall, see fig 1, column 3 lines 35-40); c) coupling the faceplate 26 to the box 12 ( see figs 1 and 5, column 5 lines 15-26, column 8 lines 10-15) ; and d) at least partially reestablishing a fire rating of the barrier (see fig 1).

Regarding claim 30, a) providing a gasket 24 (a support, see fig 5, column 3 lines 60-67, column 7 lines 45-50) comprising intumescent material (see column 3 lines 55-67); b) placing the intumescent gasket 24 between a faceplate 26 (a cover plate, see fig 5, column 5 lines 15-26, column 5 lines 60-67, column 8 lines 10-26) and an electrical box 12 (see fig 5, column 5 lines 15-26, column 8 lines 10-26) adapted to be introduced into a barrier 16 (wall, see fig 1, column 3 lines 35-40); c) coupling the faceplate 26 to the box 12 ( see figs 1 and 5, column 5 lines 15-26, column 8 lines 10-15) ; and d) at least partially reestablishing a fire rating of the barrier (see fig 1).

Regarding claim 35, a) providing a faceplate 26 (a cover plate, see fig 5, column 5 lines 15-26, column 5 lines 60-67, column 8 lines 10-26) for an electrical box 12 (see fig 5, column 5 lines 15-26, column 8 lines 10-26) adapted to be introduced into a barrier 16 (wall, see fig 1, column 3 lines 35-40) ; b) forming a gasket 24 (a support, see fig 5, column 3 lines 60-67, column 7 lines 45-62) on the faceplate 26 (see fig 1, column 4 lines 21-41, column 8

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lines 5-20), the gasket 24 comprising fire retardant material (intumescent material, see column 3 lines 60-67); c) coupling the faceplate 26 to the box 12 ( see figs 1 and 5, column 5 lines 15-26 column 8 lines 10-15); and d) at least partially reestablishing a fire rating of the barrier (see fig 1).

Regarding claims 24 and 31, further comprising coupling the gasket 24 (see fig 5) in situ between the faceplate 26 and the box 12 (see fig 5, column 5 lines 15-26, column 8 lines 10-26).

Regarding claims 25 and 32, providing the gasket 24 comprises forming the gasket 24 as a separate element (see fig 5, column 3 lines 65-67, column 4 lines 1-5, column 5 lines 60-65 and column 6 lines 60-63) prior to placing the gasket 24 between the faceplate 26 and the box 12 (see fig 5, column 5 lines 15-26, and column 5 lines 60-67).

Regarding claims 26 and 33, further comprising forming the gasket on one or more surfaces of the faceplate 26 prior to coupling the faceplate 26 to the box 12 (see column 4 lines 20-41, column 8 lines 5-20).

Regarding claims 27, 34 and 36, the gasket 24 is being formed by establishing a coating of the fire retardant material onto the faceplate 26 (see column 4 lines 21-41).

Regarding claim 28, the fire retardant material comprises intumescent material (see column see column 3 lines 60-67) .

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Regarding claim 37, installing into a fire rated barrier 16 (wall, see fig 1, column 3 lines 35-40) an electrical box 12 (see fig 5, column 5 lines 15-26, column 8 lines 10-26) , the electrical box compromising the fire resistance of the fire rated barrier (see fig 1), introducing into the electrical box a fire retardant gasket 24 (a support, see fig 5, column 3 lines 60-67, column 7 lines 45-50) ; and covering the electrical box with a faceplate 26 (a cover plate, see fig 5, column 5 lines 15-26, column 5 lines 60-67, column 8 lines 10-26) .

Regarding claim 38, the fire retardant gasket being adhered to the faceplate prior to covering the electrical box with the faceplate (see column 4 lines 1-40).

Regarding claim 39, the fire retardant gasket is an intumescent gasket (see column 3 lines 55-67, and column 4 lines 1-5)..

Regarding claim 40, the fire retardant gasket being introduced to the electrical box without removing the electrical box from the fire resistant barrier (see fig 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 29 and 41-42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rose (6,252,167) in view of applicant's own admission. Regarding claims 29, 41-42 Rose disclose all the features of the claimed invention as shown above, but fails to disclose said fire retardant material comprises fire resistant insulative material (for claims 29 and 41), and the fire

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resistant insulative material being mineral wool, ceramic fiber or intumescent graphite (for claim 42). As disclosed by applicants in the specification page 6, lines 5-15, applicant's disclose that intumescent material are known to those with ordinary skill in the art including other fire retardant material include, without limitation and merely by way of further example, fire resistant insulative material such as mineral wool, ceramic fibers, and intumescent graphite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the fire retardant material comprises fire resistant insulative material (for claims 29 and 41) and the fire resistant insulative material being mineral wool, ceramic fiber or intumescent graphite (for claim 42) as evidenced by applicant's own admission , and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

7. Applicant's arguments filed on 6/5/03 have been fully considered but they are not persuasive. In response to Applicant's argument that Rose does not recite a method of assisting such compromised barrier, the examiner respectfully disagreed because Rose clearly tech the use of a method of

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assisting compromised barrier 16 (see fig 1 and an electrical box 12 being mounted in an opening in the wall 16, see column 1 lines 18-21), with respect to Applicant's argument on page 4 that " at least partially reestablishing a fire rating of the barrier ", considering 112 second paragraph, the assembly of Rose meet the structural limitations, with respect to Applicant's argument on page 4 that Rose does not disclose the use of a fire retardant gasket, the examiner is respectfully disagreed because Rose clearly disclose a fire retardant gasket (intumescent material, see column 3 lines 55-67, please note that as disclosed by applicants in the specification page 6, lines 5-15, applicant's disclose that intumescent material are known to those with ordinary skill in the art, see page 6 line 5), with respect to Applicant's argument on page 5 concerning previously submitted Declaration of Mr Randy Clark, the DECLARATION under 37 CFR 1.132 filed dated 10/10/02 is insufficient to overcome the rejection of claims 23-36 based upon Rose reference (for claims 23-28, 30-36), and Rose in view of applicant's own admission (for claim 29) as set forth in the last Office action because Rose clearly disclosed that " conventionally , intumescent materials are applied to the exterior of an item to insulate it from a fire, and Rose disclosed that in the event of a fire, the heat generated thereby will cause the intumescent material 30 on the support 24 to begin to expand (see column 5 lines 35-37), and the expanding intumescent material 30 will fill the air gaps 32

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between the wall 16 and the electrical box 12 (see column 5 lines 39-43), therefore, it prevent a fire entering from one side of the wall 16 to another side of the wall 16, therefore, Rose does suggest barrier to a fire located outside of the box, and meet the preamble and the claimed limitations. and please note that in claim 28, the fire retardant material comprises intumescent material which is same as disclose by the rose reference, with respect to Applicant's argument on page 5 that the examiner's rejection should not be sustained therefore because each and every element as set forth in Applicant's claims are found. The examiner respectfully disagrees because Rose clearly disclosed that " conventionally , intumescent materials are applied to the exterior of an item to insulate it from a fire. For example, intumescent materials have been used to create a fire resistant/retardant wrap suitable for protecting the exterior of conduits and cable trays and the like form a fire (see column 1 lines 41-46)" , and also disclosed that " the electrical box 12 being mounted an opening in the wall 16, there is typically a small air gap 32 between the outer periphery of the electrical box 12 and the opening in the wall 16. It is preferred that the support 24 be sized to cover not only a majority of the opening in the electrical box 12, but also a majority of the air gap 32, preferably , the support 24 covers substantially all of the air gap 32 between the wall 16 and the electrical box 12 (see column 5 lines 27-34), and also disclosed that in the event of a fire, the

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heat generated thereby will cause the intumescent material 30 on the support 24 to begin to expand (see column 5 lines 35-37), and the expanding intumescent material 30 will fill the air gaps 32 between the wall 16 and the electrical box 12 (see column 5 lines 39-43), therefore, it prevent fire entering from one side of the wall 16 to another side of the wall 16. Therefore, Rose meet the claims limitations, and the rejection should be sustained.

***Contact information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is (703) 308 -3748. The examiner can normally be reached on Mondays- Thursdays from 6:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard be reached at 703-308-3682. The fax number for this Group is 703-305-3431. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Dhiru Patel

Patent Examiner

Group Art Unit 2831

July 9, 2003

*Dhiru Patel*